

REMARKS

Applicant submits this Amendment in reply to the Office Action mailed July 26, 2005.

By this Amendment, Applicant amends independent claims 1, 22, 61, and 86 to include subject matter similar to claims 110, 113, 116, and 119, respectively, amend claims 19 and 39 to conform with the subject matter of independent claims 1 and 22, amends the dependencies of claims 109, 112, 115, and 118, and cancels claims 108, 110, 111, 113, 114, 116, 117, and 119. The originally filed specification, drawings, and claims fully support the subject matter of the amended claims. No new matter has been introduced.

Before this Amendment, claims 1-39 and 61-119 were pending. After entry of this Amendment, claims 1-39 and 61-107, 109, 112, 115, and 118 are pending. Claims 1, 22, 61, and 86 are independent claims.

On pages 2-3 of the Office Action, claims 1-4, 7-10, 14-19, 22-26, 30-34, 38, 39, 61-64, 67-70, 74-79, 82, 85-90, 94-98, 102-104, and 108-119 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,059,719 to Yamamoto et al. ("Yamamoto"), or in the alternative, were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamamoto. Applicant respectfully traverses these rejections.

Yamamoto does not disclose every aspect of the claimed invention as required by Section 102(b). For example, each of as-amended independent claims 1, 22, 61, and 86 recites a device including, among other aspects, "wherein the distal assembly includes a tube and an end effector having a profile in the closed configuration that is smaller than a profile of a lumen of the tube so that at least a portion of the end effector

fits within the lumen of the tube when in the closed configuration.” Yamamoto does not disclose at least this aspect of the claimed invention either alone or in combination with the other aspects of each of respective claims 1, 22, 61, and 86.

Page 2 of the Office Action asserts that biopsy forceps 9c and module body 7, as shown in Figs. 16, 17 of Yamamoto, correspond to the end effector and the tube, respectively, of the claimed invention. Even assuming *arguendo* that this is correct, Yamamoto does not disclose that “wherein the distal assembly includes a tube and an end effector having a profile in the closed configuration that is smaller than a profile of a lumen of the tube so that at least a portion of the end effector fits within the lumen of the tube when in the closed configuration.” Specification, Yamamoto does not disclose that biopsy forceps 9c has a profile smaller than any lumen defined by module body 7 such that at least a portion of biopsy forceps 9c fits within any lumen defined by module body 7 when in the closed configuration. Indeed, biopsy forceps 9c appears to be fixed relative to module body 7 such that biopsy forceps 9c may be opened and closed by the movement of forceps 137, and thus at no time would any portion of biopsy forceps 9c be disposed within any lumen defined by module body 7 at all. Accordingly, for at least these reasons, Applicant respectfully requests withdrawal of the Section 102(b) rejection of claims 1, 22, 61, and 86.

Moreover, because the Office Action did not set forth any reasoning as to how the subject matter of dependent claims 110, 113, 116, and 119 is either present or rendered obvious in view of Yamamoto, as required by M.P.E.P. § 2142, a proper case of *prima facie* obviousness has not been established. Accordingly, for at least these

reasons, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claims 1, 22, 61, and 86.

On page 3-4 of the Office Action, dependent claims 5, 6, 11-13, 27-29, 35-37, 65, 66, 71-73, 91-93, and 99-101 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of U.S. Patent No. 6,066,102 to Townsend et al. ("Townsend"). Applicant respectfully traverses this rejection. As set forth above, Yamamoto does not disclose or suggest every aspect of independent claims 1, 22, 61, and 86. Townsend does not remedy the deficiencies of Yamamoto. Indeed, the rejection relies on Townsend only for its alleged disclosure relating to features of handles and elongate members in dependent claims. Applicant therefore respectfully requests withdrawal of the Section 103(a) rejection based on Yamamoto and Townsend.

On page 4 of the Office Action, dependent claims 20, 21, 80, 81, 83, 84, and 105-107 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of U.S. Patent No. 5,218,589 to Lichtman ("Lichtman"). Applicant respectfully traverses this rejection because Lichtman also does not remedy the aforementioned deficiencies of Yamamoto. Accordingly, for at least these reasons, Applicant respectfully requests withdrawal of the Section 103(a) rejection based on Lichtman and Yamamoto.

Applicant further submits that claims 2-21, 23-39, 62-85, 87-107, 109, 112, 115, and 118 depend either directly or indirectly from one of independent claims 1, 22, 61, and 86 and are therefore allowable for at least the same reasons that their respective independent claims are allowable. In addition, each of the dependent claims recite

unique combinations that are neither taught nor suggested by the cited references and therefore each also are separately patentable.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.


In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 13, 2005

By: 
Michael W. Kim
Reg. No. 51,880